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REMARKS35 U.S.C. 102(b) and 103(a)

In the Action of November 21, 2005, Examiner rejected claims 1 and 10 under 35 U.S.C. 102(b) as being anticipated by European Publication No. 0 777 401 to Moll ("Moll"). Examiner additionally rejected claims 2, 3, 11 and 12 under 35 U.S.C. 103(a) as being unpatentable over Moll in view of U.S. Patent No. 5,357,510 to Norizuki et al. ("Norizuki"). Applicant respectfully traverses the rejections as follows.

Examiner gave no patentable weight to features recited after the phrase "adapted to" in the claims. Applicant herein amends the claims to remove all "adapted to" phases, and thus respectfully requests that Examiner consider every feature recited in the claims against the cited prior art. In particular, claim 1 as amended includes the features of associating a first diagnostic cell counter module with a first location in a first component of a communication element, which counter module recognizing when a diagnostic cell passes the first location and tracking passage of the diagnostic cell past the first location. Claim 1 further defines that counter information relating to the diagnostic cell in the diagnostic cell counter module is analyzed to identify a failure location in a datapath in the communication element.

These above-noted features of claim 1 are neither taught nor suggested in Moll. As understood by Applicant and explained in the Action by Examiner, Moll merely describes a method for performing a loopback test between ATM points in an ATM network. In Moll, a test cell is injected into the ATM network at a first ATM switch for transfer to a second ATM switch, and then transferred back to the first ATM switch from the second ATM switch. The first ATM switch then determines if the test cell was correctly received (see for example column 7, lines 13-51 of Moll). This loopback test method described in Moll is very different from the fault isolation method claimed in amended claim 1 of the present application. The Moll method does not teach or suggest associating a diagnostic cell counter module with a first location in a

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communication element, or of analyzing the counter information relating to the diagnostic cell in the diagnostic cell counter module to identify a failure location in a datapath.

Additionally, Moll is defined to operate between "ATM points", which points are each defined as any network element that can "process, source and/or sink ATM cells" (see column 4, lines 37-38). This is distinct from the method of amended claim 1, which is directed to a datapath within a single communication element. The loopback test method of Moll that operates over different network elements is very different from the method of amended claim 1, which preferably operates to isolate a failure location in a single communication element.

For at least the above reasons, claim 1 as amended is not anticipated by Moll. Amended claim 10 recites the same features as claim 1, and it is likewise not anticipated by Moll.

With respect to the rejection of claims 2, 3, 11 and 12 under 35 U.S.C. 103(a), Applicant notes that Norizuki, like Moll, does not teach or suggest the above-noted features of amended claims 1 and 10 relating to associating a diagnostic cell counter module with a location of a datapath in a communication element and analyzing counter information relating to a diagnostic cell in the diagnostic cell counter module. As such, Applicant respectfully submits that none of claims 2, 3, 11 or 12 are rendered obvious by Moll or Norizuki, whether such references are taken alone or in combination.

In view of the above, Applicant thus respectfully traverses the rejections under 35 U.S.C. 102(b) and 103(a).

35 U.S.C. 112

In the Action of November 21, 2005, Examiner further rejected claim 1 under 35 U.S.C. 112 for reciting "said starting point" when the term has no antecedent. Claims 2-5 and 7-9 are also rejected under 35 U.S.C. 112 since they depend from claim 1. Applicant here amends claim

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1 to remove the phrase "said starting point" and thus traverses the rejections to claims 1-5 and 7-9 under 35 U.S.C. 112.

Provisional Double-Patenting Rejection

Finally, Examiner provisionally rejected all claims of the subject application on the ground of nonstatutory obviousness-type double patenting, and asserts that such claims are unpatentable over claims 1-12 of copending Application No. 10/025,742. Applicant notes that Application No. 10/025,742 was recently allowed but has not yet issued to patent. Applicant requests that Examiner reconsider the obviousness-type double patenting rejection in view of the allowed claims of Application No. 10/025,742 and the claims of the subject application as herein amended. Should this rejection be made non-provisional in a further Action, Applicant reserves the right to submit further argument or a terminal disclaimer to traverse the rejection.

New claims 16-30

Applicant herein adds new claims 16-30. New independent claims 16 and 23 recite similar features as old claims (i) 1 and 4, and (ii) 10 and 13, respectively. For at least the same reasons described above with respect to claims 1 and 10, new claims 16-30 are patentable over the cited prior art of Moll and Norizuki. Exemplary support for the new claims and claim amendments is found at Figures 4A and 4B, and at paragraphs [0059] to [0080] of the description.

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No new subject matter is provided with the present amendments. In view of the above remarks, Applicant submits that the claims are in condition for allowance. Applicant earnestly solicits that this application be permitted to proceed to allowance. The Examiner is invited to contact the undersigned by telephone to discuss this case further, if necessary.

Respectfully submitted

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Date

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